

ESTTA Tracking number: **ESTTA766599**

Filing date: **08/24/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	GMA Accessories, Inc.
Granted to Date of previous extension	08/24/2016
Address	1 East 33rd Street New York, NY 10016 UNITED STATES
Attorney information	Kevin A. Marks, Esq. The Bostany Law Firm PLLC 3 World Financial Center 24th Floor New York, NY 10281 UNITED STATES mail@bozlaw.com Phone: 2125304400

Applicant Information

Application No	86620973	Publication date	04/26/2016
Opposition Filing Date	08/24/2016	Opposition Period Ends	08/24/2016
International Registration No.	NONE	International Registration Date	NONE
Applicant	Confezioni Peserico S.p.A. Via Lucca di Cereda Cornedo Vicentino (VI), 36073 ITALY		

Goods/Services Affected by Opposition


Class 014. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Precious metals and their alloys; boxes of precious metal; jewellery, precious stones; horological and chronometric instruments
Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Leather and imitations of leather; wallets, briefcases; animal skins, hides; bags, namely, all-purpose carrying bags, tote bags, travel bags, beach bags, clutch bags; bags for sports; small bags, namely, small all-purpose carrying bags, small tote bags, small travel bags, small handbags, small beach bags, small clutchbags; handbags; leatherware, namely, travelling bags; envelopes of leather for packaging; school bags; trunks; attache cases; backpacks; leather cases; backpacks; pocket wallets; luggage, namely, trunks and suitcases; umbrellas; parasols; walking sticks; key cases
Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing, namely, sweatshirts, sweaters, T-shirts, blouses, shirts, pullovers, skirts, trousers, jackets, coats and overcoats, gloves, shawls, socks, stockings, underwear, bathing costumes, dresses and suits; footwear, headgear, namely, hats, caps,


berets

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3241182	Application Date	10/07/2006
Registration Date	05/15/2007	Foreign Priority Date	NONE
Word Mark	CAPELLI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1993/02/01 First Use In Commerce: 1993/04/22 Bracelets; Chokers; [Clocks;] Costumejewelry; Earrings; Gemstones; Gold and its alloys; Jewel chains; Jewelry; Jewelry chains; Jewelry for the head; Neck chains; Necklaces; Ornamental pins; Picture frames of precious metal; Precious gemstones; Rings being jewelry; Semi-precious gemstones; Silver and its alloys; [Watches]		

U.S. Registration No.	4409345	Application Date	06/08/2011
Registration Date	10/01/2013	Foreign Priority Date	NONE
Word Mark	CAPELLI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1991/12/30 First Use In Commerce: 1993/11/30		

	All purpose sport bags; All-purpose carrying bags; Beach bags; Dog apparel; Dogclothing; Dog coats; Dog parkas; Duffelbags; Evening handbags; Fashion handbags; Flight bags; Garments for pets; Luggage; Multi-purpose purses; Pet clothing; Pocketbooks; Pouches made from imitationleather; Purses; Travel bags
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U.S. Registration No.	3248875	Application Date	11/11/2006
Registration Date	06/05/2007	Foreign Priority Date	NONE

Word Mark	CAPELLI
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 025. First use: First Use: 1991/12/01 First Use In Commerce: 1991/12/18 Bandanas; Bathrobes; Beach footwear; Beachwear; Belts; Berets; Blazers; Blouses; Body suits; Boots; Clothing, namely, knee warmers; Clothing, namely, wrap-arounds; Coats; Cravats; Ear muffs; Earbands; Embossed soles and heels of rubber or of plastic materials; Fabric belts; Fleece pullovers; Flip flops; Footwear; Foulweather gear; Fur cloaks; Fur coats andjackets; Fur jackets; Fur muffs; Galoshes; Gloves; Gowns; Hoods; Hosiery; Housecoats; Infant and toddler one piece clothing; Infant sleepers; Infants' shoes and boots; Infants' trousers; Infantwear; Jackets; Jerseys; Jogging pants; Knee-high stockings; Lace boots; Ladies' boots;Leather belts; Leather shoes; Leg shapers; Leg warmers; Leggings; Leotards; Light-reflecting jackets; Lingerie; Long sleeved vests; Loungewear; Men's socks; Mittens; Moccasins; Mufflers; Neck bands; Neck gaiters; Neckerchiefs; Neckwear; Night gowns; Night shirts; Nightdresses; Nighties; Nightwear; One piece garment for infants and toddlers; Open-necked shirts; Pajamas; Parkas; Pullovers; Rain boots; Rain coats; Rain jackets; Rain suits; Rainproof jackets; Rainwear; Riding boots; Robes; Rubber shoes; Rubbers; Sashes; Scarves; Shawls; Shirts; Shoes; Short-sleeved shirts; Sleep shirts; Sleeping garments; Sleepwear; Sleeved or sleeveless jackets; Slippers; Socks and stockings; Suede jackets; Tank tops; Tights; V-neck sweaters; Vests; Wind coats; Wind resistant jackets; Women's shoes; Woollen socks; Wraps
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Attachments	77016426#TMSN.png(bytes) 85341679#TMSN.png(bytes) 77041971#TMSN.png(bytes) Notice.Opp.Capellini.8.24.16.pdf(913654 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/KAM/
Name	Kevin A. Marks, Esq.
Date	08/24/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X
GMA ACCESSORIES, INC.,

Opposer,

- against -

NOTICE OF OPPOSITION

CONFEZIONI PERSERICO S.P.A.,

Applicant.

-----X

Opposer's Mark: CAPELLI

Applicant's Mark: CAPPELLINI

Serial No.: 86-620,973

Class: 14, 18, and 25

Opposer GMA Accessories, Inc. ("GMA"), through its undersigned counsel of record, hereby opposes the above application to register CAPPELLINI in Classes 14, 18, and 25, and in support thereof respectfully submits as follows:

1. Applicant Confezioni Perserico S.p.A ("Confezioni"), an Italian corporation, located at Via Lucca di Cereda, Cornedo Vicentino (VI), Italy 36073, seeks to register CAPPELLINI in International Classes 14, 18, and 25.

2. GMA is the current title and status owner of the mark CAPELLI in multiple classes including International Class 14, 18 and 25.

3. A true and correct copy of the status of CAPELLI Class 14 Registration # 3,241,182 printed from the USPTO website on August 24, 2016 is attached as **Exhibit A**. This mark was deemed incontestable pursuant to section 15 on October 31, 2012.

4. A true and correct copy of the CAPELLI Class 18 Registration # 4,409,345 printed from the USPTO website on August 24, 2016 is attached as **Exhibit B**.

5. A true and correct copy of the status of CAPELLI Class 25 Registration # 3,248,875 printed from the USPTO website on August 24, 2016 is attached as **Exhibit C**.

6. GMA is the current title owner of CAPELLI Registration # 3,241,184 in International Class 24.

7. GMA is the current title owner of CAPELLI Registration # 3,246,017 in International Class 9.

8. GMA is the current title owner of CAPELLI Registration # 3,258,734 in International Class 3.

9. GMA is the current title owner of CAPELLI Registration #3,273,451 in International Class 28.

10. GMA is the current title owner of CAPELLI Registration #3,322,312 in International Class 26.

11. GMA is the current title owner of CAPELLI Registration # 3,978,297 in International Class 35.

12. GMA is the current title owner of CAPELLI Registration # 4,628,175 in International Class 41.

13. On May 6, 2015, Confezioni filed an intent-to-use application to register the mark CAPPELLINI in International Class 14, 18 and 25.

14. Confezioni seeks registration of CAPPELLINI in the same Classes and for similar goods for which GMA owns registrations.

15. The applicant's mark CAPPELLINI is likely to cause confusion with Opposer's CAPELLI mark in classes 14, 18, and 25.

16. In determining whether there is a likelihood of confusion, courts will consider whether the marks themselves are similar in appearance, sound, connotation and commercial impression. *In re. E. I. Dupont de Nemurs & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

17. Numerous courts have found a likelihood of confusion notwithstanding the inclusion of additional words, prefixes or suffixes. *In re Denisi*, 225 U.S.P.Q. 624 (TTAB 1985); *CFM Majestic, Inc. v. NHC, Inc.*, 93 F. Supp.2d 942 (N.D. Ind. 2000); *Trident Seafoods Corp. v. Triton Fisheries, LLC.*, 2000 WL 33675750 at * 6 (D. Alaska June 30, 2000); 3 *McCarthy on Trademarks* §§ 23:55-23:56 at 23-164 through 23-169.

18. In determining whether there is a likelihood of confusion, the goods or services are to be compared to be determined if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

19. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F. 2d 1565, 223 USPQ 1289 (Fed Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel, Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

20. The CAPPELLINI Mark is similar to the CAPELLI mark in appearance, sound, connotation and commercial impression.

21. The products that Applicant CAPPELLINI seeks to identify by CAPPELLINI are commercially similar and will be marketed in similar commercial channels as GMA markets CAPELLI brand products.

22. A mark shall be refused registration if it is likely to cause confusion. 15 U.S.C. § 1052(d).

WHEREFORE, GMA respectfully requests that the CAPPELLINI application be refused.

Dated: August 24, 2016

Respectfully submitted,
THE BOSTANY LAW FIRM PLLC

A handwritten signature in black ink, appearing to read 'Kevin A. Marks', is written over a horizontal line.

By: Kevin A. Marks, Esq.
Attorneys for Opposer
3 World Financial Center – 24th Floor
New York, New York 10281
(212) 530-4400

1. The Post Registration "Maintenance Tab" has been temporarily disabled. It will return soon.
2. TSDR now displays information regarding [TM5 Common Status Descriptors](#).

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Mark: CAPELLI

CAPELLI

US Serial Number: 77016426

Application Filing Date: Oct. 07, 2012

US Registration Number: 3241182

Registration Date: May 15, 2012

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status
Descriptor:

LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the USPTO.

Status: A Section 15 declaration has been acknowledged.

Status Date: Oct. 31, 2012

Publication Date: Feb. 27, 2007

Mark Information

Related Properties Information

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Bracelets; Chokers; [Clocks;] Costume jewelry; Earrings; Gemstones; Gold and its alloys; Jew
Jewelry for the head; Neck chains; Necklaces; Ornamental pins; Picture frames of precious met
jewelry; Semi-precious gemstones; Silver and its alloys; [Watches]

International Class(es): 014 - Primary Class

U.S Class(es): 002, 027,

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 01, 1993

Use in Commerce: Apr. 22, 1993

Basis Information (Case Level)

Current Owner(s) Information

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

TM Staff and Location Information

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load

United States of America
United States Patent and Trademark Office

CAPELLI

Reg. No. 4,409,345

Registered Oct. 1, 2013

Int. Cl.: 18

TRADEMARK

PRINCIPAL REGISTER

GMA ACCESSORIES, INC. (NEW YORK CORPORATION)
1 EAST 33RD STREET
NEW YORK, NY 10016

FOR: ALL PURPOSE SPORT BAGS; ALL-PURPOSE CARRYING BAGS; BEACH BAGS;
DOG APPAREL; DOG CLOTHING; DOG COATS; DOG PARKAS; DUFFEL BAGS; EVENING
HANDBAGS; FASHION HANDBAGS; FLIGHT BAGS; GARMENTS FOR PETS; LUGGAGE;
MULTI-PURPOSE PURSES; PET CLOTHING; POCKETBOOKS; POUCHES MADE FROM
IMITATION LEATHER; PURSES; TRAVEL BAGS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND
41).

FIRST USE 12-30-1991; IN COMMERCE 11-30-1993.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-
TICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 3,241,182, 3,978,297 AND OTHERS.

THE ENGLISH TRANSLATION OF "CAPELLI" IN THE MARK IS "HAIR".

SER. NO. 85-341,679, FILED 6-8-2011.

JEFFREY LOOK, EXAMINING ATTORNEY



Steven M. Kue
Deputy Director of the United States Patent and Trademark Office

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2. TSDR now displays information regarding [TM5 Common Status Descriptors](#).

STATUS

DOCUMENTS

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Mark: CAPELLI

CAPELLI

US Serial Number: 77041971

Application Filing Date: Nov. 11, 2012

US Registration Number: 3248875

Registration Date: Jun. 05, 2012

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status
Descriptor:

LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the USPTO.

Status: A Section 8 declaration has been accepted.

Status Date: Nov. 17, 2012

Publication Date: Mar. 20, 2007

Mark Information

Related Properties Information

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Bandanas; Bathrobes; Beach footwear; Beachwear; Belts; Berets; Blazers; Blouses; Body suits; Clothing, namely, wrap-arounds; Coats; Cravats; Ear muffs; Earbands; Embossed soles and heels; Fabric belts; Fleece pullovers; Flip flops; Footwear; Foul weather gear; Fur cloaks; Fur coats and Galoshes; Gloves; Gowns; Hoods; Hosiery; Housecoats; Infant and toddler one piece clothing; Infants' trousers; Infantwear; Jackets; Jerseys; Jogging pants; Knee-high stockings; Lace boots and shoes; Leg shapers; Leg warmers; Leggings; Leotards; Light-reflecting jackets; Lingerie; Long gloves; Mittens; Moccasins; Mufflers; Neck bands; Neck gaiters; Neckerchiefs; Neckwear; Night gowns;

Nightwear; One piece garment for infants and toddlers; Open-necked shirts; Pajamas; Parkas; I jackets; Rain suits; Rainproof jackets; Rainwear; Riding boots; Robes; Rubber shoes; Rubbers; Shoes; Short-sleeved shirts; Sleep shirts; Sleeping garments; Sleepwear; Sleeved or sleeveles; Suede jackets; Tank tops; Tights; V-neck sweaters; Vests; Wind coats; Wind resistant jackets; \

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 01, 1991

Use in Commerce: Dec. 18, 1

Basis Information (Case Level)

Current Owner(s) Information

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

TM Staff and Location Information

Assignment Abstract Of Title Information - Click to Load

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